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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,411	02/01/2002	Edward G. Sutt JR.	P 278449 SFS-178REG1	9553

909 7590 02/25/2005  
PILLSBURY WINTHROP, LLP  
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MCLEAN, VA 22102

EXAMINER
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BUI, LUAN KIM

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/060,411

Applicant(s)

SUTT, EDWARD G.

Examiner

Luan K Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

Applicant is required to update the current status of the co-pending applications as indicated on page 1 of the instant patent application.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-10 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Shelton (4,836,372) in view of the "Standard Specification for Driven Fasteners: Nails, Spikes, and Staples, American Society for Testing and Materials," (hereinafter ASTM). Shelton discloses a package (10) of collated nails comprising a plurality of nails (12) with each nail comprising a length including a substantially round head (14) having a head diameter, a flat top surface and a bottom surface, a single elongate shank (16) having a shank diameter, a point opposite the head and a plurality of surface deformations (50, 56) formed on the shank having a plurality of longitudinally spaced apart rings and at least one attachment element (32) constructed to temporarily attached the plurality of nails into a package. Shelton also discloses the other limitations of the claims except for the shank diameter between 0.092 to .148 inches, the length between 1.625 inches and 3.00 inches and the ratio of the head diameter to shank diameter of each nail being between 2.70 and 3.37. ASTM shows the nails in Table 36 comprising each nail having a length of 1.75 inches, a shank diameter of 0.113 inches and a head

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diameter of 0.312 inches. ASTM shows each nail having the ratio of the head diameter to the shank diameter is about 2.76. It would have been obvious to one having ordinary skill in the art at the time the invention was made in view of ASTM to modify the nails of Shelton so the shank diameter of each nail generally corresponds to a shank diameter as specified by ASTM F1667-95 comprises the shank diameter between 0.092 to .148 inches, the length between 1.625 inches and 3.00 inches and the ratio of the head diameter to shank diameter of each nail being between 2.70 and 3.37 to provide more standardize nail package. As to claims 3-4, it would have been obvious to one having ordinary skill in the art in view of Shelton as modified to increase the length of the nails to approximately 2 inches or 2.5 inches to provide more convenience for the user in a specific application and also for better securing the nails to the panel. Table 36 of ASTM shows the head diameter and the shank diameter remain unchanged when the length changes from 1.25 to 1.75 inches. With the head diameter and the shank diameter remain unchanged, the ratio of the head diameter to shank diameter is about 2.76 which is considered equivalent to "approximately 2.83" as claimed.

### ***Response to Arguments***

Applicant's arguments filed on 5/5/2004 have been fully considered but they are not deemed to be persuasive.

Applicant's arguments with respect to ASTM F1667 in the remarks are noted. They are not persuasive because ASTM F1667 was relied upon for the size/dimension of the nails and nothing more. Regarding the intended use of the claimed invention for sheathing, it has been

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held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. If the prior art structure is capable of performing the intended use, then it meets the claim. *Ex parte Masham, 2 USPQ2d 1647 (1987)*.

Shelton discloses the nails may be used for siding nails, roofing nails, dry-wall nails or other special-purpose nails (column 3, lines 51-52) and most of these nails are made from steel wire.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is (571) 272-4552. If in receiving this Office Action, it is apparent to Applicant that certain documents are missing from the record for example copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Ms. Merilyn Watts at (571) 272-4398.

Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service whose telephone number is (703) 306-5648. Facsimile correspondence for this application should be sent to (703) 872-9306 for Formal papers and After Final communications.

lkb  
February 23, 2005

A handwritten signature in black ink, appearing to read 'Luan K. Bui', with a horizontal line underneath.

Luan K. Bui  
Primary Examiner